



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Marcus Peinado et al.

Serial No.: 09/525,509

Group Art Unit: Not Yet Assigned

Filing Date: March 15, 2000

Examiner: Not Yet Assigned

For: PRODUCING A NEW BLACK BOX FOR A DIGITAL RIGHTS
MANAGEMENT (DRM) SYSTEMDATE OF DEPOSIT: Apr. 17, 2000

I HEREBY CERTIFY THAT THIS PAPER IS BEING
DEPOSITED WITH THE UNITED STATES POSTAL
SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID
ON THE DATE INDICATED ABOVE AND IS ADDRESSED
TO THE ASSISTANT COMMISSIONER FOR PATENTS,
WASHINGTON, DC 20231.

Steven H. Meyer
TYPED NAME: Steven H. Meyer
REGISTRATION NO.: 37,189

Assistant Commissioner for Patents
Washington DC 20231

Dear Sir:

INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. §1.56 and in accordance with 37 C.F.R. §§1.97-1.98, information relating to the above-identified application is hereby disclosed. Inclusion of information in this statement is not to be construed as an admission that this information is material as that term is defined in 37 C.F.R. §1.56(b).

In accordance with §1.97(b), since this Information Disclosure Statement is being filed either within three months of the filing date of the above-identified application, within three months of the date of entry into the national stage of the above identified application as set forth in §1.491, or before the mailing date of a first Office Action on the merits of the above-identified application, no additional fee is required.

- In accordance with §1.129(a), this Information Disclosure Statement is being filed in connection with the first or second After Final Submission, therefore:
 - Certification in Accordance with §1.97(e) is attached; or
 - The fee of \$240.00 as set forth in §1.17(p) is attached.
- In accordance with §1.97(c), this Information Disclosure Statement is being filed after the period set forth in §1.97(b) above but before the mailing date of either a Final Action under §1.113 or a Notice of Allowance under §1.311, therefore:
 - Certification in Accordance with §1.97(e) is attached; or
 - The fee of \$240.00 as set forth in §1.17(p) is attached.
- In accordance with §1.97(d), this Information Disclosure Statement is being filed after the mailing date of either a Final Action under §1.113 or a Notice of Allowance under §1.311 but before, or simultaneously with, the payment of the Issue Fee, therefore included are: Certification in Accordance with §1.97(e); Petition Requesting Consideration of the Information Disclosure Statement; and the fee of \$130.00 as set forth in §1.17(i)(1).
- Copies of each of the references listed on the attached Form PTO-1449 are enclosed herewith.
- Copies of references listed on the attached Form PTO-1449 are enclosed herewith EXCEPT THAT:
 - In view of the voluminous nature of references [list as appropriate], and the likelihood that these references are available to the Examiner, copies are not enclosed herewith.

-3-

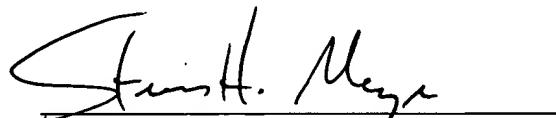
- In accordance with §1.98(d), copies of the following references listed on the attached Form PTO-1449 are not enclosed herewith because they were previously cited by or submitted to the U.S. Patent and Trademark Office in patent application(s) for which a claim for priority under 35 U.S.C. §120 have been made in the instant application:
- Copies of references [list as appropriate] listed on the attached Form PTO-1449 were previously cited by or submitted to the Patent and Trademark Office in prior application Serial No. , filed .
- If any of the foregoing publications are not available to the Examiner, Applicant will endeavor to supply copies at the Examiner's request.

Please charge any deficiency or credit any overpayment to Deposit Account No. 23-3050.
This form is submitted in duplicate.

There are no listed references which are not in the English language.

Date:

April 17 2000



Steven H. Meyer
Registration No. 37,189

WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

Form PTO-1449 Modified		Docket No. MSFT-0117	Serial No. 09/525,509
List of Patent and Publications Cited by Applicant (Use several sheets if necessary)		Applicant Marcus Peinado et al.	
U.S. Department of Commerce Patent and Trademark Office		Filing Date March 15, 2000	Group Not Yet Assigned

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

<i>DQL</i>	AA	"Aladdin Knowledge Systems Partners with Rights Exchange, Inc. to Develop a Comprehensive Solution for Electronic Software Distribution," August 3, 1998 , 5 pages
	AB	Amdur, D., "Metering Online Copyright," January 16, 1996 , 2 pages
	AC	Amdur, D. (ed.), "InterTrust Challenges IBM Digital Content Metering," <i>Report On Electronic Commerce</i> , July 23, 1996 , 3(15), 1-2 and 16-18
	AD	Armati, D., "Tools and standards for protection, control and presentation of data," April 3, 1996 , 17 pages
	AE	Benjamin, R. et al., "Electronic markets and virtual value chains on the information superhighway," <i>Sloan Management Rev.</i> , Winter, 1995 , 62-72
	AF	Cassidy, "A Web developers guide to content encapsulation technology," April, 1997 , 5 pages
	AG	Clark, T., "Software Secures Digital Content on Web," <i>Interactive Week</i> , September 25, 1995 , 1 page
	AH	Cox, B., "Superdistribution," <i>Idees Fortes</i> , September, 1994 , 2 pages
	AI	Cox, B., "What if There Is A Silver Bullet," <i>J. Object Oriented Programm.</i> , June, 1992 , 8-9 and 76
	AJ	Griswold, G.N., "A Method for Protecting Copyright on Networks," <i>IMA Intell. Property Project Proceedings</i> , January, 1994 , 1(1), 169-178
	AK	Hauser, R.C., "Does licensing require new access control techniques?" August, 1993 , 9 pages
	AL	Hudgins-Bonafield, C. "Selling Knowledge on the Net," <i>Network Computing</i> , June 1, 1995 , 102-109
<i>✓</i>	AM	"IBM spearheading intellectual property protection technology for information on the Internet," May, 1996 , 3 pages

EXAMINER

DATE CONSIDERED

2/10/03

Form PTO-1449 Modified		Docket No. MSFT-0117	Serial No. 09/525,509
<p style="text-align: center;">O I P E APR 20 2000 P A T E N T & T R A D E M A R K O F F I C E List of Patent and Publications Cited by Applicant (Use several sheets if necessary)</p>		<p>Applicant Marcus Peinado et al.</p>	
<p>U.S. Department of Commerce Patent and Trademark Office</p>		Filing Date March 15, 2000	Group Not Yet Assigned

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

<i>Dan</i>	AN	"Technological Solutions Rise to Complement Law's Small Stick Guarding Electronic Works," <i>Information Law Alert</i> , June 16, 1995, 3-4 and 7
	AO	Kaplan, M.A., "IBM Cryptolopes_, Super-Distribution and Digital Rights Management," December, 1996, 7 pages
	AP	Kent, S.T., "Protecting externally supplied software in small computers," September, 1980, 1-42 and 250-252
	AQ	Kohl, U. et al., "Safeguarding Digital Library Contents and Users; Protecting Documents Rather Than Channels," <i>D-Lib Magazine</i> , September, 1997, 9 pages
	AR	Linn, R.J., "Copyright and Information Services in the Context of the National Research and Education Network," <i>IMA Intell. Property Project Proceedings</i> , January, 1994, 1(1), 1 and 10-20
	AS	McNab, L., "Super-distribution works better in practical applications," March 2, 1998, 2 pages
	AT	Moeller, M., "NetTrust lets Cyberspace Merchants Take Account," <i>PC Week</i> , November 20, 1995, 12(48), 1 page
	AU	Moeller, M., "IBM takes charge of E-commerce; Plans client, server apps based on SET," April, 1996, 4 pages
	AV	Pemberton, J., "An ONLINE Interview with Jeff Crigler at IBM InfoMarket," July, 1996, 7 pages
	AW	"LicensIt: kinder, gentler copyright? Copyright management system links content, authorship information," <i>Seybold Report on Desktop Publishing</i> , 1996, 10(11), 2 pages
	AX	Sibert, O. et al., "The DigiBox: A Self-protecting Container for Information Commerce," <i>First USENIX Workshop on Electronic Commerce</i> , July 11-12, 1995, 171-183
<i>✓</i>	AY	Sibert, O. et al., "Securing the Content, Not the Wire, for Information Commerce," July, 1995, 1-11

EXAMINER

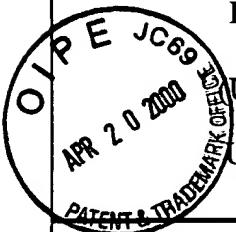
DATE CONSIDERED

Form PTO-1449 Modified		Docket No. MSFT-0117	Serial No. 09/525,509
List of Patent and Publications Cited by Applicant (Use several sheets if necessary)		Applicant Marcus Peinado et al.	
U.S. Department of Commerce Patent and Trademark Office		Filing Date March 15, 2000	Group Not Yet Assigned

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

<i>DPL</i>	AZ	Smith, M.G. et al., "A New Set of Rules For Information Commerce," <i>Electronic Commerce</i> , November 6, 1995, 34-35
	BA	Stefik, M., 'Trusted Systems,' March, 1997, 8 pages
	BB	Stefik, M., "Shifting the Possible: How Trusted Systems and Digital Property Rights Challenge Us to Rethink Digital Publishing," <i>Technical Perspective</i> , 1997, 137-159
	BC	Tarter, J. (ed.), "The Superdistribution Model," <i>Soft Trends</i> , November 15, 1996, 13(6), 1-6
	BD	"Rights Management in the Digital Age: Trading in Bits, Not Atoms," Spring, 1997, 4, 3 pages
	BE	Weber, R., "Digital Rights Management Technology," October, 1995, 1-49
	BF	White, S.R. et al., 'ABYSS: An Architecture for Software Protection,' <i>IEEE Trans. On Software Engineering</i> , June, 1990, 16(6), 619-629
	BG	White, S.R. et al., "ABYSS: A trusted architecture for software protection," <i>IEEE Symposium on Security and Privacy</i> , April 27-29, 1987, 38-51
	BH	"Boxing Up Bytes," 2 pages
	BI	Ramanujapuram, A. et al., "Digital Content & Intellectual Property Rights: A specification language and tools for rights management," December, 1998, 20-23 and 26
<i>↓</i>		
EXAMINER	DATE CONSIDERED	

Form PTO-1449 Modified		Docket No. MSFT-0117	Serial No. 09/525,509
List of Patent and Publications Cited by Applicant (Use several sheets if necessary)		Applicant Marcus Peinado et al.	
U.S. Department of Commerce Patent and Trademark Office		Filing Date March 15, 2000	Group Not Yet Assigned

**U. S. PATENT DOCUMENTS**

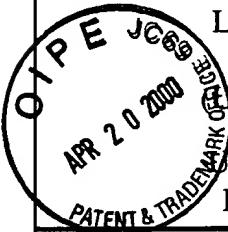
Examiner Initial		Document No.	Date	Name	Class	Subclass
<i>DL</i>	BJ	3,718,906	02/27/73	Lightner	340	147 R
	BK	4,323,921	04/06/82	Guillou	358	114
	BL	4,528,643	07/09/85	Freeny, Jr.	364	900
	BM	4,658,093	04/14/87	Hellman	380	25
	BN	4,683,553	07/28/87	Mollier	380	4
	BO	4,827,508	05/02/89	Shear	380	4
	BP	4,916,738	04/10/90	Chandra et al.	380	25
	BQ	4,953,209	08/28/90	Ryder, Sr. et al.	380	23
	BR	4,977,594	12/11/90	Shear	380	4
✓	BS	5,050,213	09/17/91	Shear	380	25

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Country	Translation YES	NO
<i>DL</i>	BT	EP 0 715 246 A1	06/05/96	EPO	X	
	BU	EP 0 715 247 A1	06/05/96	EPO	X	
	BV	WO 93/01550	01/21/93	PCT	X	
✓	BW	WO 96/13013	05/02/96	PCT	X	

EXAMINER	DATE CONSIDERED

Form PTO-1449 Modified

Docket No.
MSFT-0117Serial No.
09/525,509Applicant
Marcus Peinado et al.Filing Date
March 15, 2000Group
Not Yet AssignedList of Patent and Publications
Cited by Applicant
(use several sheets if necessary)U. S. Department of Commerce
Patent and Trademark Office

U. S. PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Name	Class	Subclass
DJL	BX	5,103,392	04/07/92	Mori	395	725
	BY	5,103,476	04/07/92	Waite et al.	380	4
	BZ	5,109,413	04/28/92	Comerford et al.	380	4
	CA	5,117,457	05/26/92	Comerford et al.	380	3
	CB	5,193,573	03/16/93	Chronister	137	315
	CC	5,222,134	06/22/93	Waite et al.	380	4
	CD	5,319,705	06/07/94	Halter et al.	380	4
	CE	5,410,598	04/25/95	Shear	380	4
	CF	5,509,070	04/16/96	Schull	380	4
✓	CG	5,629,980	05/13/97	Stefik et al.	380	4

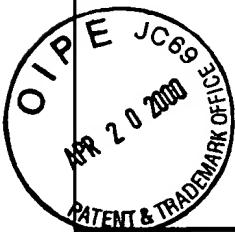
FOREIGN PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Country	Translation YES	NO
DJL	CH	WO 96/24092	08/08/96	PCT	X	
✓	CI	WO 96/27155	09/06/96	PCT	X	
	CJ	WO 97/25798	07/17/97	PCT	X	
✓	CK	WO 97/43761	11/20/97	PCT	X	
✓	CL	WO 98/09209	03/05/98	PCT	X	

EXAMINER

DATE CONSIDERED

Form PTO-1449 Modified		Docket No. MSFT-0117	Serial No. 09/525,509
List of Patent and Publications Cited by Applicant (Use several sheets if necessary)		Applicant Marcus Peinado et al.	
U.S. Department of Commerce Patent and Trademark Office		Filing Date March 15, 2000	Group Not Yet Assigned

**U. S. PATENT DOCUMENTS**

Examiner Initial		Document No.	Date	Name	Class	Subclass
DQ	CM	5,634,012	05/27/97	Stefik et al.	395	239
	CN	5,638,443	06/10/97	Stefik et al.	380	4
	CO	5,673,316	09/30/97	Auerbach et al.	380	4
	CP	5,710,887	01/20/98	Chelliah et al.	395	226
	CQ	5,715,403	02/03/98	Stefik	395	244
	CR	5,765,152	06/09/98	Erickson	707	9
	CS	5,809,144	09/15/98	Sirbu et al.	380	25
✓	CT	5,845,281	12/01/98	Benson et al.	707	9

FOREIGN PATENT DOCUMENTS

Examiner Initial		Document No.	Date	Country	Translation YES	NO
DQ	CU	WO 98/10381	03/12/98	PCT	X	
	CV	WO 98/21679	05/22/98	PCT	X	
	CW	WO 98/24037	06/04/98	PCT	X	
✓	CX	WO 98/37481	08/27/98	PCT	X	

EXAMINER	DATE CONSIDERED